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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,093	08/16/1999	MIN-JAE HAN	6715/57089	2372

7590

11/16/2005

JAY H MAIOLI
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1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliant Appeal Brief
(37 CFR 41.37)**

Application No.

09/319,093

Applicant(s)

HAN, MIN-JAE

Examiner

Kambiz Abdi

Art Unit

3621

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

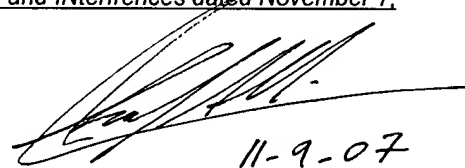
The Appeal Brief filed on 14 March 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☒ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and **relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☒ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

Please refer to the attached Order to Return from the Board of Patent Appeals and Interferences dated November 7, 2005.

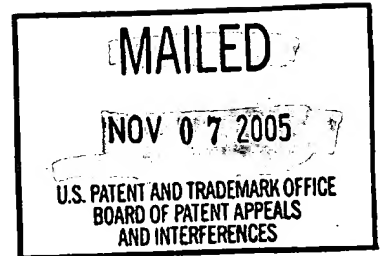

11-9-07

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIN-JAE HAN GWYN ROMANS

Application No. 09/319,093



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on August 12, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

Appellant filed an Appeal Brief on March 14, 2005. However, the brief appears to have been filed under 37 CFR § 1.192 as evidenced by heading "7. Grouping of Claims" on page 5 of the brief. Likewise, the Examiner's Answer mailed May 12, 2005, also seems to follow the 37 CFR § 1.192(c) format. However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced by 37 CFR § 41.37 and as such the brief and the answer should have been filed and answered under 37 CFR § 41.37.

37 CFR § 41.37 states:

(c)(1) The brief will contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

Specific examples of discrepancies in the brief in the instant application are missing headings (v) Summary of claimed subject matter, (ix) Evidence Appendix and (x) Related Proceedings Appendix. Also, the headings Summary of Invention and Grouping of Claims in the present brief are no longer included under the new rules. A substitute brief that is in compliance with § 41.37(c) is required. For more information, see the United States Patent and Trademark website www.uspto.gov, and, in particular, the web page entitled "More Information on the Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule" located at the following URL:

www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

Additionally, a revised examiner's answer that corresponds with the headings as set forth in the new rules under § 41.37 is required. For the required content in an examiner's answer under the new rules, the examiner is directed to the Manual Of Patent Examining Procedure (MPEP) § 1207.02(A) (8th ed., Rev. 3, August 2005).

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) to hold the Appeal Brief filed March 14, 2005, defective and notification to appellant to file a substitute Appeal Brief in compliance with the new rules as set forth under 37 CFR § 41.37;

Application No. 09/319,093


2) for consideration of the substitute Appeal Brief, to vacate the Examiner's Answer mailed May 12, 2005, and issue a revised Examiner's Answer that complies with the new rules under § 41.37;

3) for the examiner to sign and date the IDS filed January 12, 2000, and to mail a copy of the corrected IDS to appellant, and

4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:


CRAIG FEINBERG
Program and Resource Administrator
(571) 272-9797

CF/vsh

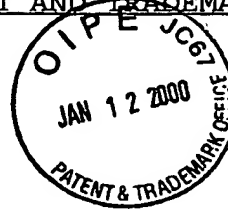
cc: JAY H. MAIOLI
COOPER & DUNHAM
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

6715/57089

2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Han Min-Jae
Serial No.: 09/319,093
Filed : May 28, 1999
For : RECORD/PLAYBACK APPARATUS AND RECORD/PLAYBACK
METHOD



Group A.U.:

I hereby certify that this paper is being deposited
this date with the U.S. Postal Service in first
class mail addressed to: Assistant Commissioner for
Patents, Washington, D.C. 20231.

Jay H. Maioli
Reg. No. 27,213

Jay H. Maioli
January 7, 2000
Date

January 7, 2000
1185 Avenue of the Americas
New York, NY 10036
(212) 278-0400

INFORMATION DISCLOSURE STATEMENT


Assistant Commissioner for Patents
Washington, D.C. 20231


Sir:

As a means of complying with the duty of disclosure set forth in 37 C.F.R. § 1.56 and in keeping with the guidelines of 37 C.F.R. § 1.98, Applicant hereby submits information thought to be relevant to the above-identified application. Also submitted herewith is a completed form PTO-1449.

This information came to light during examination of a counterpart European Patent Application in the European Patent

Office in an Office Action dated November 5, 1999, and it is hereby certified that this information is being submitted within three months of that date.

 U.S. Patent No. 4,703,465 (Parker) apparently relates to machines capable of selecting a multiplicity of randomly chosen audio selections from a tape library and transmitting the selected tapes to a duplicating center where they are duplicated onto a master blank recording tape in a desired order. Specifically, Parker addresses a machine which would allow a consumer to make a recording based on selections available from a tape library. Parker includes an audio/video display of available recordings, accepts payment for customized tapes, makes change for the money deposited for the customized tape, allows the user to select songs for the tape, allows the user to confirm his or her selection, records a cassette of appropriate length based on the users selections, and issues a completed cassette to the user.

 European Patent Application 0 309 298 (Ball et al.) apparently relates to a system that allows a customer to select various randomly accessible musical pieces to be copied at a rapid speed onto a tape for immediate purchase, and that automatically records and forwards the appropriate royalty payments to the artists involved. According to one embodiment of Ball et al., selections are stored and edited on a video tape by means of an audio to video digital converter. The selections are

transferred to video disk to form a library, and are retrieved for duplication on a cassette by means of a video to audio digital converter. Higher than normal duplication is achieved through the use of a burst mode input and a rate buffer output.

KA European Patent Office Patent Abstract of Japan
04178798 (Shigeru) apparently relates to a dubbing device which selects an arbitrary recorded medium to be dubbed on a video tape in a main body, records the frequency of the program being dubbed while dubbing each pre-recorded cassette, and sends the frequency data to a host computer. In Shigeru, a user inserts a credit card to pay a charge for use of the device. An optical disk of pre-recorded cassette tape is reproduced at high speed using a reproduction device. A dubbing device is used synchronously with the reproduction device in order to dub the pre-recorded cassette tape on a video tape. The frequency of the dubbed data is sent to a host computer as management data so that a record can be maintained as to which artist's works has been copied.

KA European Patent Office Patent Abstract of Japan
62277681 (Satoru) apparently relates to an apparatus that allows a user to select an artist's work for dubbing on a recording medium that can be removed and reproduced externally. In Satoru, a user inserts cash and a cassette tape into the apparatus, selects the program he or she wishes to dub onto the cassette tape, and activates a dubbing device which dubs the selected program at a high speed.

(K.A.) European Patent Office Patent Abstract of Japan
01113959 (Takeshi) apparently relates to a device for reproducing writings that allows reproduction while protecting the author's copyright interest. Every reproduction of a work causes a reduction in a reproducible degree number associated with the work and stored in an internal counter of the device. When the reproducible degree number reaches 0 or a negative number, the apparatus no longer allows reproduction of that work.

(K.A.) German Patent 24 29 469 (Luther) is in the German language. No English language translation of this reference is presently available to those individuals identified in 37 C.F.R. § 1.56(c). A copy of the European Search Report from the European Patent Office is included herewith indicating the relevance of this reference to the above-identified application.

No fee is deemed necessary in connection with the filing of this Information Disclosure Statement. However, if a fee is required for this submission, the Commissioner is authorized to charge the requisite fee to Deposit Account No. 03-3125.

(Signature)
11-2-09

Respectfully submitted,

COOPER & DUNHAM LLP

(Signature)
Jay H. Maioli
Reg. No. 27,213

JHM/KJB
encl.